

REMARKS/ARGUMENTS

Initially, it is respectfully submitted that the Finality of the Office Action is improper because the Examiner has asserted for the very first time in the Final Office Action that the provisional application upon which priority has been claimed does not appear to provide express support for the claimed invention (Final Office Action, paragraph 4, pages 4-5). In addition, it is respectfully submitted that Finality of the Office Action is also improper because the Examiner has raised several new issues for the very first time in the Final Office Action based on evidence that was admittedly "newly discovered by the Examiner" (Final Office Action, page 6). Clearly, the Applicant has NOT been given an opportunity to address any of the issues newly raised by the Examiner when prosecution was reopened in response to the appeal brief filed March 23, 2004. Accordingly, it is respectfully submitted that the office action should NOT have been made final at this time.

Nevertheless, solely in order to expedite prosecution, the Applicant will address all the newly raised issues rather than reinstating the Appeal. Since the Examiner has reopened prosecution, it is respectfully submitted that the Examiner should enter the declaration submitted herewith under 37 CFR § 1.132. Furthermore, solely in order to avoid further delay in issuance of this application, the Applicant will address all the newly raised issues without relying on the priority claimed from the provisional application. However, it should be noted that the Applicant reserves the right to rely on the priority claimed from the provisional application.

Claim rejections based on the presentation made on March 26, 1998

The Applicant has already submitted that the Examiner has NOT made a prima facie case that the claimed invention was publicly disclosed during the presentation on March 26, 1998 (see, for example, Appeal Brief). Despite the Examiner's failure to establish a prima facie case, the Applicant has also submitted on the record that several features of the claimed invention were NOT publicly disclosed during the presentation on March 26, 1998 (see, for example, Appeal Brief). In addition, the Applicant further

submits the declaration of Mr. Robert Field, a co-inventor of the present application for the Examiner's consideration. As noted in the declaration of Mr. Robert Field, the claimed features relating to "automatically generating the front and back-end of the debugger program portions based on the parsing of a formal specification" (see, for example claim 20) were NOT publicly disclosed or otherwise made available to the public during the presentation entitled "The New Java™ Platform Architecture," on March 26, 1998, at the Moscone Convention Center in San Francisco.

In the Final Office Action, the Examiner has NOT submitted any new evidence even remotely suggesting that the claimed invention was publicly disclosed during the presentation on March 26, 1998. Instead, the Office Action seems to assert that the burden of establishing a prima facie case of rejection rests with the Applicant and has required the Applicant to put forth "convincing evidence" showing that the claimed invention was not demonstrated or discussed prior to one year before the instant application (Office Action, page 7). It is respectfully submitted that the burden rests with the Examiner to provide factual evidence that can support a specific allegation that the claimed invention was demonstrated or discussed prior to one year before the instant application. In this case, the Examiner is imposing on the Applicant the burden of overcoming an implicit general allegation that has NO factual basis. The undersigned earnestly believes that shifting the burden to the Applicant without at least making a specific allegation which is at least remotely supported by factual evidence is clearly improper. Aside from the fact that a presentation was made on March 26, 1998, the Examiner has NOT even made a specific allegation supported by factual evidence that the claimed invention was publicly discussed or demonstrated in that demonstration, despite Applicant's statements on the record that the claimed invention was not discussed in that presentation. Furthermore, the undersigned earnestly believes that the clear and "convincing" standard that the Examiner seems to be imposing has no legal basis. In view of the foregoing, it is respectfully submitted that the Examiner's rejection based on the presentation on March 26, 1998 is improper and should be immediately withdrawn to avoid further delay in issuance of the present application. Again, the Applicant respectfully reiterates the arguments submitted in the appeal brief with respect to the rejection of the claims under 35 U.S.C 102(b) and 103(a). As was

noted in the Amendment dated March 20, 2003, the features that were NOT disclosed by the Applicant in any component of the presentation made on March 26, 1998 include: inputting a formal specification into a code generator, parsing the formal specification, generating a front-end debugger program portion from the formal specification, and generating a back-end debugger program portion from the formal specification in the context of the claimed invention.

Newly Raised allegations in the Final Office Action

In the Office Action that Examiner has alleged for the very first time that three (3) “releases” of the Java™ Platform Debugger were made prior to the filing date of the present application. Each of these assertions will be addressed below.

The Early Access JBUG

The Applicant respectfully points out that the May 1998 “Early access” of the Java Platform Debugger Architecture (Jbug), among other things, did NOT include the claimed features of automatically generating the front and back-end of the debugger program portions based on the parsing of a formal specification. A declaration of Mr. Robert Field, a co-inventor of the present application, which attests to this point is enclosed with this response. The Applicant further points out that the provisional application 60/145,136, filed July 21, 1999 includes a section entitled the “changes since early access” which corroborates Mr. Robert Field’s declaration. The section entitled the “changes since early access,” states that “JDWP [is] now formally specified and mechanically generated,” It is respectfully submitted that this makes it clear that the Early Access version of the JWDP did not automatically generate a front-end or back-end debugger program portion from the formal specification.

The Beta Tests

The Applicant respectfully submits that that both the Beta 1 (December 1998) and Beta 2 (March 20, 1999) testing of the Java Platform Debugger Architecture (Jbug)

were confidential experimental uses of the Jbug that did not in any way constitute public uses or disclosures of the claimed inventions. To support this statement, the Applicant refers to the declaration of Mr. Robert Field, a co-inventor of the present application, which is included herewith. As pointed out by Mr. Field, the Beta 1 and Beta 2 testing of the Java Platform Debugger Architecture (Jbug) were governed by a specific Beta Testing Software License. The Applicant further submits a copy of the Jbug Beta Software License which governed the usage of both the Beta 1 and Beta 2 Jbug testing that was referenced by the Examiner.

Initially, it should be noted that the Jbug Beta Software License includes a **non-disclosure agreement** that strictly forbids disclosure of confidential information by the testers to any third party (See, Jbug-beta Software License, section 3). Accordingly, it is respectfully submitted that both Beta tests were clearly not public disclosures within the context of 102(b) since the testers who conducted the Beta testing were subject to strict non-disclosure agreements. Further, the testers did not purchase the Beta software and were licensed to use the software for only a sixty (60) day test period (please see, Jbug-beta Software License, section 1, BETA TESTING PERIOD). Therefore, it is respectfully submitted that the Beta tests did not in any way constitute sales or offers to sell the corresponding software. Additionally, it is pointed out that the purpose of the Beta testing was entirely experimental. Thus, one of the primary goals of the Beta testing was to identify bugs in the software so that any defects or deficiencies that were present in the experimental version of the Java Platform Debugger Architecture (Jbug) could be fixed. Therefore even if there was an inadvertent public usage (or disclosure) of the Beta software (of which neither Mr. Field nor the undersigned are aware), it is respectfully submitted that such a usage would have been experimental in nature and therefore would not constitute a statutory bar under 35 USC 102(b).

In view of the foregoing, it is respectfully submitted that the Beta 1 (December 1998) and Beta 2 (March 20, 1999) testing of the Java Platform Debugger Architecture

(Jbug) do NOT constitute public uses within the context of 35 USC 102(b) and that the outstanding rejections on this basis should be withdrawn.

Conclusion

Accordingly, it is requested that the Examiner withdraw the pending rejections under 35 U.S.C. §102(b) or 103 (a). Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fees for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 500388 (Order No. SUN1P252). Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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